IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ted A. BARNES	§	
	§	
Serial Number: 10/727,697	§	
	§	Group Art Unit: 3727
Filed: December 4, 2003	§	
	§	
For: ACCESSORY MOUNT FOR VEHICLE CONTROL BODIES	§	Examiner: Lester L. Vanterpool
	§	

APPEAL BRIEF

Dear Sir,

This Appeal Brief is submitted in reply to the Final Office Action dated August 12, 2008.

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APPEAL BRIEF

Statement of Real Party of Interest
37 C.F.R. § 41.37(c)(1)(i)

The real parties of interest in this patent application are the inventor, Ted A Barnes of 4514 Tranquility Drive, Garland, Texas 75043, and Storm LLP of 901 Main Street, Suite 7100, Dallas, Texas 75202.

Related Applications and Interferences
37 C.F.R. § 41.37(c)(1)(ii)

U.S. Application No. 10/778,385, filed February 13, 2004, is a related application. There are no Interferences in this or the related application.

Status of the Claims
37 C.F.R. § 41.37(c)(1)(iii)

There are 19 pending claims numbered as Claims 1-19. Claims 1, 7, 8, 15, and 19 are independent claims. All claims were rejected in a Final Office Action dated August 12, 2008.

a. Claims 1, 3 and 5 stand rejected as anticipated under 35 USC § 102(b) by Masui et al. (US Patent 6,305,241).

b. Claim 2 is rejected under 35 USC § 103(a) as obvious due to Masui et al. in view of Ho (US Patent 6,062,053).

c. Claim 4 is rejected under 35 USC § 103(a) as obvious due to Masui et al. in view of Chen (US Patent 6,644,614).

d. Claims 6 and 7 are rejected under 35 USC § 103(a) as obvious due to Masui et al. in view of Penning (US Patent 5,827,282).

e. Claims 8 - 10, 12, 14, 17, and 19 are rejected under 35 USC § 103(a) as obvious due to Masui et al. in view of Japan Patent 4-133886.

f. Claim 11 is rejected under 35 USC § 103(a) as obvious due to Masui et al. and Japan Patent 4-133886, further in view of Chen.

g. Claims 13 and 18 are rejected under 35 USC § 103(a) as obvious due to Masui et al. and Japan Patent 4-133886, further in view of Ho (US Patent 6,062,053).

h. Claims 15 and 16 are rejected under 35 USC § 103(a) as obvious due to Masui et al. and Japan Patent 4-133886 in view of Penning.

Status of the Amendments
37 C.F.R. § 41.37(c)(1)(iv)

No Amendment was filed responsive to the Final Office Action of August 12, 2008. The Final Office Action, now under appeal, rejected Applicant's arguments for patentability presented in the last Amendment, which was filed on June 12, 2008. The Final Office Action took the position that the claim preambles merely recite the intended use of the claimed structures. [See, page 12, third paragraph of the Final Office Action]. The preamble portion being ignored states: "a handle-barred vehicle throttle or clutch control body." Applicant traversed the nullifying of this language and conducted the interview of August 19, 2008, through its counsel to discuss this issue. Applicant also provided copies of case law in support of its position that the preambles of the instant claims breathe life and meaning into the claims and should be accorded weight in assessing patentability in order to encourage favorable reconsideration. However, as explained in more detail in Applicant's concurrently filed Supplemental Interview Summary, no agreement was reached.

The Claims Appendix attached reflects the currently pending claims as presented in the Amendment of June 12, 2008, prior to the Final Office Action.

Summary of the Claimed Subject Matter
37 C.F.R. § 41.37(c)(1)(v)

The subject matter of the patent application generally relates to aspects of an accessory mount device 10 shown in the example of FIGS. 2 and 4 that may be mounted to a control bracket 106 of a throttle or clutch control body 104 on a handle bar 102 of a motor vehicle 100. The device 10 is affixed to the control body 104 so that an accessory 200 may be mounted to it. The accessory may include, for example, a GPS navigation device, music player, radar detector, etc.

For ease of explanation, the following detailing of the subject matter of each independent claim will refer to the examples shown in the drawing FIGURES of the application with the understanding that the claims are not limited to the exemplary embodiments shown in these drawings.

Claim 1

The subject matter of independent Claim 1 relates to a vehicle accessory mount 10, shown in detail in the exemplary embodiment in FIGS. 4-6. The mount 10 is adapted for attachment to a control bracket 106 (FIG. 2) of a throttle or clutch control body 104 (FIG. 2) of a handle-barred vehicle 100. The vehicle accessory mount 10 has an accessory mount body 12 adapted for attachment to the control bracket 106 of the vehicle 100 via a pair of substantially parallel mounting holes 20, 22 that extend through the body 12. These mounting holes 20, 22 are aligned with portals 108, 114 in the control bracket 106. Further, a radial relief 35 is located between the parallel mounting holes 20, 22 of the accessory mount body 12. The accessory mount body 12 also has a threaded accessory hole 18 or 20. Thus, the accessory mount body 12 may be attached to the control bracket 106 via fasteners 40, 42 that extend through the mounting holes 20, 22 and control bracket portals 108, 114 to threadedly connect with the control body 104.

Claim 7

Claim 7 relates to a vehicle accessory mount 10 adapted for attachment to a control bracket 106 of a handle-barred vehicle throttle or clutch control body 104, as shown, for example, in FIG. 2. The accessory mount 10 includes a body 12 adapted for attachment to the control bracket 106 and there is a pair of substantially parallel mounting holes 20, 22 extending through the body 12. The mounting holes 20, 22 are aligned with portals 108, 114 in the control bracket 106. A ball stud 30 or 34 is attached to the body 12. The body 12 is attachable to the control bracket 106 by location of fasteners 40, 42 through the mounting holes 20, 22 and control bracket portals 108, 114 in threaded connection with the control body 104.

Claim 8

Claim 8 relates to a vehicle accessory mount 10 adapted for attachment to a control bracket 104 of a handle-barred vehicle throttle or clutch control body 106, as shown, for example, in FIG. 2. The accessory mount 10 has a body 12 adapted for attachment to the control bracket 106. The body 12 has a pair of substantially parallel mounting holes 20, 22 extending through it. The mounting holes 20, 22 are aligned with portals 108, 114 in the control bracket 106. A pair of hollow standoffs 36, 38 is locatable between the mounting holes 20, 22 and bolt portals 108, 114 in the control bracket 106. The body 12 has a threaded accessory hole 28 or 32. The body 12 is attachable to the control bracket 106 by location of fasteners 40, 42 through the mounting holes 20, 22 and standoffs 36, 38, and control bracket portals 108, 114 in threaded connection with the control body 104, as seen in FIGS. 4 and 5, for example.

Claim 15

Claim 15 relates to a vehicle accessory mount 10 adapted for attachment to a control bracket 106 of a handle-barred vehicle throttle or clutch control body 104, as exemplified in FIG. 2. The accessory mount 10 has a body 12 adapted for attachment to the control bracket 106. The body 12 includes a pair of substantially parallel mounting holes 20, 22 extending through it. These mounting holes 20, 22 are aligned with portals 108, 114 in the control bracket 106. A pair of hollow standoffs 36, 38 is locatable between the mounting holes 20, 22 and the portals 108, 114. A ball stud 30 or 34 is attached to the body. The body 12 is attachable to the control bracket 106 by location of fasteners 40, 42 through the mounting holes 20, 22 and standoffs 36, 38, and control bracket portals 108, 114 in threaded connection with the control body 104.

Claim 19

Claim 19 relates to a vehicle accessory mount 10 adapted for attachment to a control bracket 104 of a handle-barred vehicle throttle or clutch control body 106, as exemplified in FIG. 2. The accessory mount 10 has a body 12 adapted for attachment to the control bracket 106. The body 12 has a threaded accessory hole 28 or 32 therein. Further, the body 12 has a pair of substantially parallel mounting holes 20, 22 extending through it. These mounting holes 20, 22 are aligned with portals 108, 114 in the control bracket 106. There is a pair of hollow standoffs

36, 38 locatable between the mounting holes 20, 22 and the bolt portals 108, 114 in the control bracket. The body 12 is attachable to the control bracket 104 by location of fasteners 40, 42 through the mounting holes 20, 22 and standoffs 36, 38, and control bracket portals 108, 114 in threaded connection with the control body 104.

Grounds of Rejection to be Reviewed on Appeal
37 C.F.R. § 41.37(c)(1)(vi)

Applicant requests review of each of nine (9) grounds for final rejection of the pending claims.

The first ground for appeal is the Final Office Action assertion that the preambles of the pending claims are "mere statements of intended use" and are not to be accorded any weight in an assessment of patentability of the claims. Accordingly, this ground of Appeal may be summarized as:

1. *Whether the preambles to the claims breathe life and meaning into each claim so that the preambles should be accorded full weight in assessing patentability over the cited prior art.*

Applicant also requests review of the following eight (8) grounds for appeal from the final rejection of the claims:

2. *Whether Claims 1, 3 and 5 are anticipated under 35 USC § 102(b) by Masui et al. (US Patent 6,305,241).*
3. *Whether Claim 2 is obvious under 35 USC § 103(a) due to Masui et al. in view of Ho (US Patent 6,062,053).*
4. *Whether Claim 4 is obvious under 35 USC § 103(a) due to Masui et al. in view of Chen (US Patent 6,644,614).*
5. *Whether Claims 6 and 7 are obvious under 35 USC § 103(a) due to Masui et al. in view of Penning (US Patent 5,827,282).*
6. *Whether Claims 8 - 10, 12, 14, 17, and 19 are obvious under 35 USC § 103(a) due to Masui et al. in view of Japan Patent 4-133886.*

7. *Whether Claim 11 is obvious under 35 USC § 103(a) due to Masui et al. and Japan Patent 4-133886, further in view of Chen.*
8. *Whether Claims 13 and 18 are obvious under 35 USC § 103(a) due to Masui et al. and Japan Patent 4-133886, and further in view of Ho (US Patent 6,062,053).*
9. *Whether Claims 15 and 16 are obvious under 35 USC § 103(a) due to Masui et al. and Japan Patent 4-133886 in view of Penning.*

As explained in the Supplemental Interview Summary filed concurrently with this Brief, Applicant had no notice in the Final Office Action that the preamble was being objected to for reason of the use of the term "or" in reference to the "throttle or clutch" bodies. This issue was not raised at the interview either, but appears for the first time in the Examiner Summary of the Interview. Accordingly, it does not appear to be a matter ripe for appeal. Applicant respectfully submits that this issue does not preclude a ruling of the grounds presented here because these grounds do not rely on this language and therefore it should have no effect. In the event that the Board finds the claimed subject matter allowable, as Applicant earnestly urges, then Applicant may amend the "or" language of the preamble, in consultation with Examiner. Applicant does, however, believe that the term "or" is now acceptable in the claim language and is not objectionable for lack of clarity or otherwise.

In addition, Applicant respectfully requests that the Board instruct Examiner to permit an amendment to Claim 19 to clarify and to avoid any potential antecedent basis issue. This issue was not raised in any Office Action. The claim initially recites "portals" and further in the claim refers to "bolt portals." Applicant seeks to delete the word "bolt" for purposes of clarity and to ensure proper antecedent basis.

Arguments
37 C.F.R. § 41.37(c)(1)(vii)

1. *Whether the preambles to the claims breathe life and meaning into each claim so that the preambles should be accorded full weight in assessing patentability over the cited prior art.*

Applicant submits that the case law supports the proposition that, in this instance, the preambles to the claims breathe life and meaning into the claims so that they should be accorded full weight in assessing patentability. Applicant submits that in the instant claims, the case law supports this interpretation. For example, in an interference proceeding, this Board ruled that the preamble to a claim (or count) should be given weight in construing the claim. The (losing) junior party appealed to the federal court. In *Griffin v. Bertina*, 285 F.3d 1029; 2002, U.S. App. LEXIS 5644; 62 U.S.P.Q.2d (BNA) 1431 (Fed. Cir. 2002), the court affirmed the ruling of this Board. The *Griffin* court held that "the Board did not err in construing the count to be limited by the preamble." In arriving at its holding, *Griffin* noted, in particular, that the preamble language was directed to "diagnosing an increased risk for thrombosis of a genetic defect causing thrombosis," (emphasis added) and that this "[diagnosing] aspect of the invention is again stated in the body of the count." Accordingly, *Griffin* teaches that when an aspect of the claimed invention that is recited in the preamble is also reflected in the body of the claim, then the preamble "gives life and meaning" to the claimed invention so that the preamble is entitled to full weight in assessing patentability. *Griffin* also cited long-standing and well-known precedent, including *Kropa v. Robie*, 38 C.C.P.A. 858, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (stating that a preamble is limiting when it is "necessary to give life, meaning and vitality to the claims or counts") before arriving at its holding that the preamble gives life and meaning to the claim and should be given weight.

Griffin provided a second rationale for affirming the Board. The Court noted that in the absence of the preamble's objective to diagnose thrombosis, the method step of obtaining a test sample from a "test subject" would be meaningless. *Griffin* queried: "What is one testing for and who is a suitable subject?" The Court also found that, without the preamble, the assaying step would be meaningless. Accordingly, *Griffin* holds that where a part of the body of the claim would be rendered meaningless without the preamble, the preamble should be accorded weight in construing the claim.

Aside from *Griffin*, in *Boehringer Ingelheim Vet Medica Inc.v Schering Plough Corp. et al.*, 20 F.3d 1339; 2003 U.S. App. LEXIS 3232; 65 U.S.P.Q.2D (BNA) 1961 (Fed Cir 2003), the Court held that: "[A] preamble simply stating the intended use or purpose of the invention will usually not limit the scope of the patent claim, unless the preamble provides antecedents for ensuing claim terms and limits the claim accordingly (emphasis added). Thus, *Boehringer* teaches that where the

preamble provides antecedent basis for features recited in the body of a claim, the preamble should be accorded full weight in interpreting the claim.

Although the issue of giving weight to the "wherein" clause was not raised in the Final Office Action, it is worth noting that *Griffin* also affirmed the Board's ruling giving limiting effect to the wherein clauses at issue. Again, *Griffin* reasoned that "wherein" clauses should be limiting when they "relate back to and clarify what is required by the count." In particular, as to one of the "wherein" clauses, *Griffin* noted that it "elaborates the meaning of the preamble, by indicating that the point mutation correlates with a decrease in the degree of inactivation of human Factor V and/or human Factor Va by APC (*i.e.*, increased APC resistance), and hence an increased risk of thrombosis."

Applicant submits that *Griffin* and *Boehringer* are both applicable in the instant application for the following reasons:

1. As in *Griffin*, the body of each claim reflects language of the preamble. For example, Claims 1, 7, 8, 15, and 19 (and their respective dependent claims) recite "wherein the body is attachable to *the* control bracket," and the preamble recites "[A] vehicle accessory mount adapted for attachment to "a control bracket" of a throttle or clutch control body of a handle-barred vehicle. Accordingly, as in *Griffin*, where the "diagnosing" language in the preamble that was also reflected in the body of the claim was determinative, here the "control bracket" language from the body of the claim reflects an aspect of the preamble which also recites a "control bracket." Furthermore, the "the control bracket" language in the body of the claim also relies on the preamble for antecedent basis, as in *Boehringer*. This provides a first basis for giving weight to the preamble in assessing patentability of the claimed subject matter.

2. While in *Griffin* the body of the claims only reflected one feature ("diagnosing") of the preamble, here at least two features are so reflected and the case is even more compelling to give weight to the preamble. Aside from the "control bracket" discussed above, each claim body also reflects "control body" language of the preamble. For example, each independent claim (and therefore their respective dependent claims) recites "wherein . . . control bracket portals in threaded connection with the control body," and the preamble recites "[A] vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body." Accordingly, as in *Griffin*, where the "diagnosing" language in the preamble that was also reflected

in the body of the claim was determinative, here the "control body" language from the body of the claim (the wherein clause) reflects an aspect of the preamble which also recites a "control body." Furthermore, the "the control body" language in the body of the claim also relies on the preamble for antecedent basis. This provides a second basis for giving weight to the preamble in assessing patentability of the claimed subject matter.

3. As in *Griffin*, the preamble provides a context without which the claim body is meaningless. Without the "control bracket" and "control body" language in the preamble that provides the context of a "handle-barred vehicle," the "control bracket" and "control body" language in the body of the claim may be meaningless. To paraphrase the *Griffin* query, "What is the control body, what is the control bracket, and how are they related to each other?" The answer is provided in the preamble which states that the control bracket relates to the control body of a clutch or throttle controller of a handle-barred vehicle. This provides a third basis for giving weight to the preamble in construing the claimed subject matter.

4. As in *Boehringer*, the preamble in each pending claim provides antecedent basis for a term used in the body of the claim. For example, each claim recites "wherein the body is attachable to *the* control bracket," and the preamble recites "[A] vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body." Accordingly, as in *Boehringer*, the preamble provides antecedent basis for the language, "*the* control body," in the body of the claim. This provides another basis for giving weight to the preamble in assessing patentability of the claimed subject matter.

The Final Office Action correctly states, and then misapplies, the case law. At page 12, the Office Action states the applicable law, as follows:

> "A preamble is generally not accorded patentable weight where it merely recites the purpose of a process or an intended use of a structure, and where the body of the claim does not depend on the preamble for completeness, but instead, the process steps or structural limitations are able to stand alone." (Citing *In re Hirao* and *Kropa v Robie*) (emphasis added).)

Applicant agrees with the above statement of the law, which is consistent with Applicant's Federal Circuit case law, cited above, but points out that in the present application, the body of each of the claims depends upon the preamble for completeness and, indeed, even for antecedent basis to

comply with 35 USC § 112. For example, Claim 1 (and its dependent claims) recites "wherein the body is attachable to *the* control bracket," and the preamble recites "[A] vehicle accessory mount adapted for attachment to *a* control bracket of a handle-barred vehicle." Accordingly, the preamble provides antecedent basis for the "*the* control bracket" language in the body of the claim. The claim therefore depends upon the preamble in order to meet the antecedent basis requirement of 35 USC § 112. According to *Boehringer*, this is itself sufficient to rule that the preamble should be accorded full weight. Applicant respectfully submits that the Final Office Action misapplied the case law to the claims pending in this patent application.

Applicant respectfully requests a ruling from the Board that the preambles of all pending claims breathe life and meaning into the claims and should be given full weight in assessing patentability. Further, that the pending claims are patentable over the cited art when the preambles of the claims are taken into consideration, as required by law.

2. *Whether Claims 1, 3 and 5 are anticipated under 35 USC § 102(b) by Masui et al. (US Patent 6,305,241).*

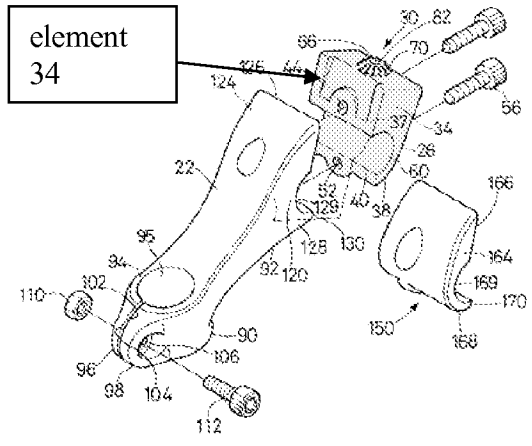
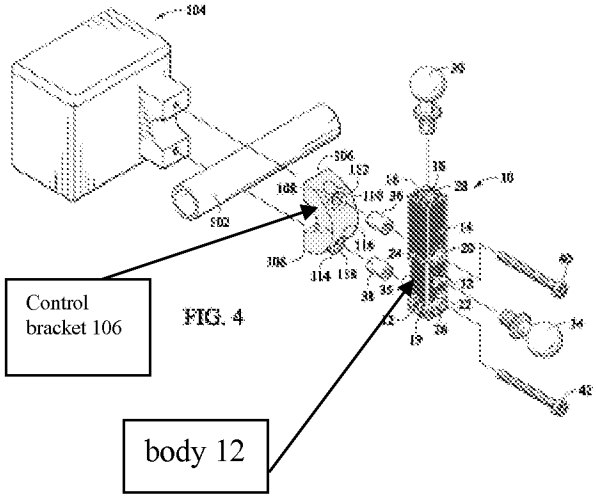
According to MPEP §2131, in order for a reference to anticipate a claim, the reference must disclose each and every feature of the claimed subject matter. Applicant respectfully contends that Masui does not disclose each and every feature recited in Claim 1. For example, Final Office Action states at page 2:

> Masui et al., discloses the body (34) adapted for attachment to the control bracket (124, 126, 128 & 130); the pair of substantially parallel mounting holes (44 & 52) extending through the body (34) (See Figure 1); the mounting holes (44 & 52) aligned with portals (1st and 2nd Threaded Blind Holes) in the control bracket (124, 126, 128 & 130); the radial relief (60, 120) located between the parallel mounting holes (44 & 52); the threaded accessory hole (82) in the body (34) . . . and, wherein the body (34) is attachable to the control bracket (124, 126, 128 & 130) by location of fasteners (48 & 56) through the mounting holes (44 & 52) and control bracket portals (1st and 2nd Threaded Blind Hole) in threaded connection with the control body (22) (See Column 4, lines 41 - 65) (See Figure 3).

For ease of explanation, Applicant will first compare Masui with an exemplary embodiment in the drawings of the application on the understanding that the scope of the claimed subject matter is not limited to these drawings and embodiments.

Compare FIGS. 3 and 11 of Masui and an exemplary embodiment of the present application, shown in FIG. 4. Referring to Masui, element 34 is not "a body 12 adapted for attachment to the control bracket 106" (numerals refer to FIG. 4 of the application), as recited in Claim 1 of the present application. Instead, element 34 of Masui is described as a "first mounting section 34," and it attaches directly to one side of the handlebar stem as shown in FIG. 11. A pair of bolts 48 and 56 extend through the body of element 34 to thread into element 50 so that elements 34 and 50 are securely bolted to the outside of the handle bar stem 18. Thus, element 34, unlike exemplary body 12 of the claimed subject matter, is NOT adapted for attachment to a control bracket, as recited in Claim 1.

The claimed body of the accessory mount is adapted for attachment to a control bracket of a control body on a handle barred vehicle, as recited in the preamble of Claim 1, which should be accorded weight as explained above. It is not adapted for direct mounting to the handle bar stem itself, in sharp contrast to element 34 of Masui which has that very purpose. This may be more clearly apparent from the drawings below:

Cited Art Masui	Exemplary Embodiment
 FIG. 3	 FIG. 4

As can be seen from the above side-by-side comparison, exemplary control bracket 106 of FIG. 4 of the present application is configured to partially surround a handle bar 102. Control bracket 106 may be mounted to the control body 104 with the handle bar 102 between them. The FIG. 4 example of the claimed accessory mount 10 has a body 12 that mounts to a rear side of control bracket 106 which in turn mounts to a control body 104 with a pair of bolts 40, 42. Element 34 does not mount to a control bracket of a control body. Indeed, Masui fails to show a control body or its associated control bracket. These features are simply absent from Masui. Accordingly, Applicant submits that there are substantial differences between element 34 of Masui and accessory device 10. both structurally and functionally.

Applicant respectfully requests that in view of the above explanation, the rejection of Claim 1, and its dependent claims, under 35 U.S.C. §102(b) be withdrawn and that Claims 1, 3 and 5 be allowed.

3. *Whether Claim 2 is obvious under 35 USC § 103(a) due to Matsui et al. in view of Ho (US Patent 6,062,053).*

Claim 2 depends from Claim 1, and should be interpreted, as explained above in ground 1, to include the preamble of Claim 1. Ho relates to a quick release locking device for loading a bag or basket to a bicycle. The primary reference, Masui, does not teach or suggest a body that is attachable to a control bracket of a throttle or clutch control body of a handle-barred vehicle. Ho is being asserted solely to show that countersunk screws or bolt holes are known in the art because Masui does not show such countersunk holes. However, Ho does not supply the deficiencies of Masui, which also lacks a "body" that is "adapted for attachment to the control bracket" of a throttle or clutch control body of a handle-barred vehicle. Masui only shows an element 34 adapted for direct attachment to the handle bar. Thus, element 34 of Masui does not correspond to the "body" of Claim 2, and Ho does not teach or suggest such a body. Accordingly, the combination of Masui with Ho cannot render Claim 2 obvious. Applicant therefore respectfully requests that the Board find Claim 2 patentable over the cited art.

4. *Whether Claim 4 is obvious under 35 USC § 103(a) due to Masui et al. in view of Chen (US Patent 6,644,614).*

Claim 4 depends from Claim 1, and should be interpreted, as explained above, to include the preamble of Claim 1. FIG. 2 of Chen, which relates to a microphone "positioning device," is being asserted solely to show a threaded accessory hole located between the mounting holes. The primary reference, Masui, does not teach or suggest a body that is attachable to a control bracket of a throttle or clutch control body of a handle-barred vehicle. However, Chen, like Masui, does not show such a body that is "adapted for attachment to the control bracket" of a handle-barred vehicle. Thus, Chen does not supply the deficiencies of Masui. As explained above in more detail, with reference to Claim 1, Masui shows an element 34 adapted for direct attachment to the handlebar. Element 34 does not correspond to the "body" of Claim 4 and Chen does not teach or suggest such a body. Accordingly, the combination of Masui with Chen cannot render Claim 4 obvious. Applicant therefore respectfully requests that the Board find Claim 4 patentable over the cited art.

5. *Whether Claims 6 and 7 are obvious under 35 USC § 103(a) due to Masui et al. in view of Penning (US Patent 5,827,282).*

Claims 6 and 7 depend from Claim 1, and should be interpreted, as explained above, to include the preamble of Claim 1. Thus, the body recited in both claims is attachable to a control bracket of a throttle or clutch control body of a handle-barred vehicle. Claim 6 includes a ball stud threaded to an accessory hole. Claim 7 includes an accessory hole substantially perpendicular to the mounting holes.

Masui shows an element 34 adapted for direct attachment to the handlebar. Element 34 does not correspond to the "body" of Claims 6 and 7, as explained above with reference to Claim 1. Penning is cited solely to show a "ball stud" used for attachment of an accessory device. Penning relates to ball joint clamps used in medical orthopedic devices, such as replacement hip joints, not to the attachment of accessory devices to handle-barred vehicles. Penning does not teach or suggest a ball stud attached to a threaded accessory hole of the body, as in Claim 6, nor does it teach or suggest a threaded accessory hole that is substantially perpendicular to the mounting holes, as in Claim 7. Penning, like Masui, does not show a body that is "adapted for attachment to the control bracket" of a throttle or clutch control body of a handle-barred vehicle. Thus, Penning does not supply the deficiencies of Masui. Accordingly, the combination of

Masui with Penning cannot render Claims 6 or 7 obvious. Applicant therefore respectfully requests that the Board find Claims 6 and 7 patentable over the cited art.

6. *Whether Claims 8 - 10, 12, 14, 17 and 19 are obvious under 35 USC §103(a) due to Masui et al. in view of Japan Patent 4-133886.*

Claim 8 is independent and Claims 9, 10, 12, 14, 17, and 19 depend from it. Claim 8 (and its listed dependent claims) should be interpreted, as explained above, to include the preamble of the claims. Thus, the body recited in each claim is attachable to a control bracket of a throttle or clutch control body of a handle-barred vehicle. Masui shows an element 34 adapted for direct attachment to the handlebar. Element 34 does not correspond to the "body" of the listed claims, as explained in more detail above, with reference to Claim 1.

FIG. 3 of Japan Patent 4-133886, for which there is no available translation, is asserted to show the "hollow standoffs" recited in Claim 8, the generally rectangular body recited in Claim 9, the radial relief located between parallel mounting holes recited in Claim 10, the threaded accessory hole perpendicular to the mounting holes as recited in Claim 12, the substantially same inside diameters of the hollow standoffs and the mounting holes as in Claim 14, the location of the standoffs in a recess in the control bracket in Claim 17, and the pair of standoffs locatable in "the recess in the control bracket" which is not the language of Claim 19.

Each of Claims 8, 9, 10, 12, 14, 17, and 19 includes a body that is "adapted for attachment to the control bracket" of a throttle or clutch control body of a handle-barred vehicle. This feature is not found in the primary Masui reference because the asserted element 34 fails to meet these requirements, as explained in more detail above with reference to Claim 1. For the combination of FIG. 3 of Japan Patent 4-133886 and Masui to render the claims obvious, it must teach or suggest all the limitations of the claims. As explained above, FIG. 3 of Japan Patent 4-133886 is cited for very specific details only with respect to each rejected claim. It is not asserted as supplying the deficiency of Masui as to the failure to teach or suggest a body adapted for attachment to a control bracket of a control body of a handle-barred vehicle. Japan Patent 4-133886, like Masui, does not show a body that is "adapted for attachment to the control bracket" of a throttle or clutch control body of a handle-barred vehicle. Thus, it does not supply the

deficiencies of Masui. Accordingly, the combination of Masui and Japan Patent 4-133886 fails to teach or suggest the subject matter of each of the rejected claims and cannot render these legally obvious. Applicant therefore respectfully requests that the Board find Claims 8, 9, 10, 12, 14, 17, and 19 patentable over the cited art.

7. *Whether Claim 11 is obvious under 35 USC § 103(a) due to Masui et al. and Japan Patent 4-133886, further in view of Chen.*

Claim 11 depends from Claim 8, and should be interpreted, as explained above, to include the preamble of Claim 8. Thus, Claim 11 includes a body that is "adapted for attachment to the control bracket" of a throttle or clutch control body of a handle-barred vehicle. This feature is not found in the primary Masui reference because the asserted element 34 fails to meet these requirements, as explained above in more detail with reference to Claim 1. FIG. 2 of Chen is being asserted solely to show a threaded accessory hole located between the mounting holes. However, Chen relates to a microphone "positioning device." Like Masui, Chen does not show a body that is "adapted for attachment to the control bracket" of a handle-barred vehicle. Thus, Chen does not supply the deficiencies of Masui. As explained in more detail above, with reference to Claim 1, Masui shows an element 34 adapted for direct attachment to the handlebar. Element 34 does not correspond to the "body" of Claim 11 and Chen does not teach or suggest such a body. Accordingly, the combination of Masui with Chen cannot render Claim 11 obvious. Applicant therefore respectfully requests that the Board find Claim 11 patentable over the cited art.

8. *Whether Claims 13 and 18 are obvious under 35 USC § 103(a) due to Masui et al. and Japan Patent 4-133886, and further in view of Ho (US Patent 6,062,053).*

While the Final Office Action refers to "Japan 4-133886 and further in view of Ho," the rationale of the Office Action only refers to Ho and does not assert Japan Patent 4-133886. Being without adequate notice of the Final Office Action's position on Japan Patent 4-133886, Applicant's response is restricted to Masui in view of Ho.

Claims 13 and 18 depend from Claim 8, and should be interpreted, as explained above, to include the preamble of Claim 8. Thus, Claims 13 and 18 each includes a body that is "adapted for attachment to the control bracket" of a throttle or clutch control body of a handle-barred vehicle. This feature is not found in the primary Masui reference because the asserted element 34 fails to meet these requirements, as explained above in more detail with reference to Claim 1. As to Claim 13, Ho is asserted to show a countersink portion with diameter larger than a cylinder portion. As to Claim 18, Ho is asserted as showing standoffs locatable within the countersink portion. As to each claim, Ho is not asserted as teaching or suggesting the primary deficiency of the primary Masui reference, namely, a body adapted for attachment to a control bracket of a handle-barred vehicle's throttle or clutch control body. Accordingly, the combination of Masui and Ho does not teach or suggest features of Claims 13 and 18 and cannot render these claims obvious. Applicant therefore respectfully requests that the Board find Claims 13 and 18 patentable over the cited art.

9. Whether Claims 15 and 16 are obvious under 35 USC § 103(a) due to Masui et al. and Japan Patent 4-133886 in view of Penning.

Claim 15 is independent and Claim 16 depends from Claim 15. Each claim should be interpreted, as explained above, to include the preamble of Claim 15. Thus, Claims 15 and 16 include a body that is "adapted for attachment to the control bracket" of a throttle or clutch control body of a handle-barred vehicle. This feature is not found in the primary Masui reference because the element 34 fails to meet the requirements of the recited "body," as explained in more detail above, with reference to Claim 1.

As to Claim 15, Japan Patent 4-133886 is cited solely for showing a pair of hollow standoffs located between the mounting holes and portals, and Penning solely for showing a ball stud attached via a threaded hole. Penning relates to ball joint clamps used in medical orthopedic devices, such as replacement hip joints, not to the attachment of accessory devices to handle barred vehicles. Penning does not teach or suggest a ball stud attached to a threaded accessory hole of the body, which is adapted for attachment to a control bracket of a throttle or clutch control body. Neither Japan Patent 4-133886 nor Penning provide the fundamental deficiency of Masui and neither teach nor suggest a body that is "adapted for attachment to the control

bracket" of a throttle or clutch control body of a handle-barred vehicle. Accordingly, the combination of Masui and Penning does not teach or suggest features of Claims 13 and 18 and cannot render these claims obvious. Applicant therefore respectfully requests that the Board find Claims 13 and 18 patentable over the cited art.

Secondary Consideration

In connection with each of the foregoing Claims, Applicant also respectfully requests that the Board consider the Declaration of Ted A. Barnes, of record in the Application and filed on January 12, 2007. This Declaration shows indicia of non-obviousness; namely, copying by another and commercial success.

CONCLUSION

Applicant respectfully submits that the explanations and applicable case law provided support a finding that all claims now pending are allowable over the cited art. In addition, a minor amendment to Claim 19 should remove any objection based in lack of clarity or antecedent basis. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 1 - 19.

Applicant includes the fees for a Notice of Appeal and the filing of this Appeal Brief. Applicant does not believe that any other fees are due; however, in the event that any fees are due, the Commissioner is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper to Deposit Account 50-2180 of Storm LLP.

Should the Examiner require any further clarification to place this Application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

Dated: November 6, 2008

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Claims Appendix
37 C.F.R. § 41.37(c)(1)(viii)

1. A vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body, comprising:
a body adapted for attachment to the control bracket;
a pair of substantially parallel mounting holes extending through the body;
the mounting holes aligned with portals in the control bracket;
a radial relief located between the parallel mounting holes;
a threaded accessory hole in the body; and,
wherein the body is attachable to the control bracket by location of fasteners through the mounting holes and control bracket portals in threaded connection with the control body.

2. The vehicle accessory mount of Claim 1, each mounting hole further comprising:
a cylinder portion; and,
a countersink portion that is larger in diameter than the cylinder portion.

3. The vehicle accessory mount of Claim 1, further comprising:
wherein the body is generally rectangular.

4. The vehicle accessory mount of Claim 1, further comprising:
wherein the threaded accessory hole is located between the mounting holes.

5. The vehicle accessory mount of Claim 1, further comprising:
wherein the threaded accessory hole is located in substantially perpendicular relationship to the mounting holes.

6. The vehicle accessory mount of Claim 1, further comprising:
a ball stud attached to the threaded accessory hole.

7. A vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body, comprising:
a body adapted for attachment to the control bracket;
a pair of substantially parallel mounting holes extending through the body;
the mounting holes aligned with portals in the control bracket;
a ball stud attached to the body; and,
wherein the body is attachable to the control bracket by location of fasteners through the mounting holes and control bracket portals in threaded connection with the control body.

8. A vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body, comprising:
a body adapted for attachment to the control bracket;
a pair of substantially parallel mounting holes extending through the body;
the mounting holes aligned with portals in the control bracket;
a pair of hollow standoffs locatable between the mounting holes and bolt portals in the control bracket;
a threaded accessory hole in the body; and,
wherein the body is attachable to the control bracket by location of fasteners through the mounting holes and standoffs and control bracket portals in threaded connection with the control body.

9. The vehicle accessory mount of Claim 8, further comprising:
wherein the body is generally rectangular.

10. The vehicle accessory mount of Claim 8, the body further comprising:
a radial relief located between the parallel mounting holes.

11. The vehicle accessory mount of Claim 8, further comprising:
wherein the threaded accessory hole is located between the mounting holes.

12. The vehicle accessory mount of Claim 8, further comprising:
wherein the threaded accessory hole is located in substantially perpendicular relationship to the mounting holes.

13. The vehicle accessory mount of Claim 8, each mounting hole further comprising:
a cylinder portion; and,
a countersink portion that is larger in diameter than the cylinder portion.

14. The vehicle accessory mount of Claim 8, further comprising:
wherein the inside diameter of each hollow standoff is substantially the same as the inside diameter of the cylinder portion of the mounting holes.

15. A vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body, comprising:
a body adapted for attachment to the control bracket;
a pair of substantially parallel mounting holes extending through the body;
the mounting holes aligned with portals in the control bracket;
a pair of hollow standoffs locatable between the mounting holes and the portals;
a ball stud attached to the body; and,
wherein the body is attachable to the control bracket by location of fasteners through the mounting holes and standoffs and control bracket portals in threaded connection with the control body.

16. The vehicle accessory mount of Claim 8, further comprising:
wherein the threaded accessory hole in the body is receivable of one of an accessory and a ball stud in threaded connection.

17. The vehicle accessory mount of Claim 8, further comprising:
wherein each standoff is locatable in a recess on the control bracket.

18. The vehicle accessory mount of Claim 8, further comprising:
wherein each standoff is locatable in a countersunk portion on the control bracket.

19. A vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body, comprising:
a body adapted for attachment to the control bracket;
a threaded accessory hole in the body;
a pair of substantially parallel mounting holes extending through the body;
the mounting holes aligned with portals in the control bracket;
a pair of hollow standoffs locatable between the mounting holes and bolt portals in the control bracket; and,
wherein the body is attachable to the control bracket by location of fasteners through the mounting holes and standoffs and control bracket portals in threaded connection with the control body.

Evidence Appendix

37 C.F.R. § 41.37(c)(1)(ix)

No secondary evidence has been supplied in this case.

Related Proceedings Appendix

37 C.F.R. § 41.37(c)(1)(x)

No related decisions rendered by a court or the Board of Patent Appeals and Interferences.